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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/764,647  
Filing Date: January 26, 2004  
Appellant(s): TRAN, BAO

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Bao Tran  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 08/28/06 appealing from the Office action mailed 06/27/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claim 15 was rejected under 35 U.S.C 112, first paragraph for failing to comply with the written description requirement in both the non-final office action dated 03/06/06 and the final office action dated 06/27/06.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2002/0161603 A1	Gonzales	10-2002
6,567,799 B2	Sweet et al.	05-2003
2004/0059994	Fogel et al.	03-2004
5,999,664	Mahoney et al.	12-1999
2004/0205542 A1	Barger et al.	10-2004

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites "mapping intellectual property for an industry covered by the patent or patent application". It is unclear what the claim is intended to mean, as there is no description for this feature in the Appellant's specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10, 12-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03.

In reference to claims 1 and 19-21, Gonzales teaches an interactive publishing system for providing content management. Gonzales teaches a browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document. See page 1, paragraph [0007]. Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Compare to ***“embedding one or more links in the first portion referencing one or more external documents” and “embedding one or more links in the third portion referencing information contained in the second portion”***.

Gonzales does not expressly teach the one or more external documents are “viewable using a viewer application”; although he does teach viewing the documents

via a browser. Sweet teaches retrieving documents linked to an initial document.

Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***“documents viewable using a viewer application”***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales’ system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 2, Gonzales does not teach the document is a PDF document residing in a PDF file; however Sweet does. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***“documents viewable using a viewer application”***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales’ system because it was desirable to provide a means to convert

Art Unit: 2176

a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 3, Gonzales does not teach encapsulating one or more links into a PDF file; however Sweet does. Sweet teaches the PDF document may have hypertext links to web pages, as well as internal pages within the document. The link is integrated into the PDF document and displayed by the PDF viewer. See column 8, lines 42-50. It would have been obvious to a person of ordinary skill in the art at the time of the invention to encapsulate the links into the PDF file because it allows a user to link to a page within the PDF document. See column 8, lines 42-50.

In reference to claim 4, Gonzales does not teach the viewer application is a PDF application; however, Sweet does. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***"documents viewable using a viewer application"***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup



representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 5, Gonzales does not teach retrieving one or more pages of an external document referenced by a link and consolidating all pages into the external document; however, Sweet does. Sweet teaches a web page integrator which is a part of a PDF viewer. The PDF viewer may request the integrator to retrieve from one or more web servers, an initial document specified by a URL supplied by the user or other documents which are linked, directly or indirectly, to the initial document. When the documents are retrieved, the web page integrator integrates them into a single PDF document which is then displayed by the PDF viewer. See column 8, lines 26-41. It would have been obvious to a person of ordinary skill in the art at the time of the invention to consolidate all pages into the external document because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 6, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can

comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 7, Gonzales teaches a web page (i.e. document) includes areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a claim section; however, the claim section is merely a

paragraph of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 10, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a the claim of a patent application and file history because a claim and file history are simply text.

In reference to claim 11, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claims 12-13, Gonzales teaches a database contains data relating to articles and documents that are developed by the users of system over the Internet. See pages 2, paragraph [0040] and page 3, paragraphs [0045].

In reference to claim 14, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 15, Gonzales teaches the document comprises text. This text could be related to a patent application or patent. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention,

Art Unit: 2176

a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 6 above, and further in view of Fogel et al., US 2004/0059994, 03/25/04 (filed 12/02/02).

In reference to claims 8-9, Gonzales/Sweet do not teach visualizing the claims in a tree view or drilling down details of each claim in the tree view; however Fogel does. Fogel teaches a method of checking semantic and syntactical correctness of claims in a claim tree format. The dependencies tree for each claim is built with at least one independent claim. See abstract and page 8. It would have been obvious to a person of ordinary skill in the art at the time of the invention to represent patent claims in a tree view as it depicts the relationships among independent and dependent claims or among text of a particular section. See page 5, paragraph [0229].

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 1 above, and further in view of Mahoney et al., US 5,999,664, 12/07/99.

In reference to claims 16-17, Gonzales/Sweet do not disclose using OCR from an image of the page and associating text with the corresponding location of the text in the image; however, Mahoney does. Mahoney teaches it was well known at the time of the invention to utilize OCR for search and retrieval of a document image. OCR distinguishes each bitmap of a character from its neighbor, analyzes the appearance, and distinguishes it from other characters in a predetermined set of characters. See page 3, lines 5-51. Mahoney further teaches scanned images may be represented as PDF documents. See column 1, lines 34-40. It would have been obvious to a person of ordinary skill in the art at the time of the invention to enable searching a document using OCR in a PDF document as it was desirable at the time of the invention to search for a document stored in a large database particularly hardcopy documents that are scanned as images having no structural definition as it would not be perceivable by a computer, thus there was a need to analyze image data and pixels to help identify a document stored in a large corpus of documents. See columns 1-2 of Mahoney.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, US 2002/0161603 A1, 10/31/02 in view of Sweet et al., US 6,567,799 B2, 05/20/03, as applied to claim 1 above, and further in view of Barger on et al., US 2004/0205542 A1, 10/14/04 (filed 09/07/01).

In reference to claim 18, Gonzales/Sweet do not teach saving user annotations in the document; however, Barger on does. Barger on teaches the anchoring of

annotations to content. On page 1, paragraph [0005], Bargerón discloses an annotation is associated with a particular portion of content. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Bargerón's annotation in the document in the system of Gonzales/Sweet as it was desirable to provide a means to preserve the annotations in a digital document because digital documents are easily and frequently altered, thereby changing the portion of the document to which the annotation corresponds. It would thus be beneficial to provide a way to improve the manner in which annotations are associated with portions of documents so that the annotations are still associated with the correct portion of the document despite alterations to the underlying content. See page 1, paragraph [0004].

#### **(10) Response to Argument**

##### **I. Claims 1-7, 10, 12-15, and 19-21**

Regarding claim 1, Appellant argues, on page 5 of the Brief, that the Examiner does not show Gonzales teaches one or more links in the first portion referencing one or more external document viewable using a viewer application and that the Examiner cannot show that Gonzales teaches one or more links in the third portion referencing information contained in the second portion. Examiner disagrees with Appellant.

Gonzales discloses a document comprises several regions or portions. Appellant agrees that this is true for Web pages in general on page 5. Appellant then argues that web pages typically jump to other pages and all web pages cannot be scrolled and viewed sequentially, one page after another, like a typical document.



However, it is noted that claim 1 does not recite such features. Claim 1 simply recites “embedding one or more links in the first portion reference one or more external documents viewable using a viewer application and embedding one or more links in the third portion referencing information contained in the second portion”.

Gonzales teaches a browser-based publishing tool allows a user to create a document that includes a hyperlink enabling a person viewing the document to navigate from a first point in the document to a second point in the document, or further to another document. See page 1, paragraph [0007]. The ability to navigate from one point in a document to a second point in a document meets the limitation, ***embedding one or more links in the third portion referencing information contained in the second portion***. Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component which meets the limitation, ***embedding one or more links in the first portion referencing one or more external documents***. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2.

Gonzales teaches a document comprises several regions or portions. The Appellant agrees with this statement on page 5 of the Brief. Gonzales therefore discloses an “external link” which allows a user to click on a hyperlink connecting them to another document as well as an “internal link” where a user can connect from one

point in the document to another point. Therefore, Gonzales teaches that one region or portion of a document can have a hyperlink referencing an external document and another region can contain a link connecting to another region in the document. See figure 2, page 1, paragraph [0007], and page 3, paragraph [0046]-[0048].

Regarding claim 1, Appellant further argues on page 6 that links from the third portion cross-references information in the second portion to enable a viewer to interpret occurrences of noun phrases recited in the third section. Again, it is noted that these are not features that are claimed. All that is claimed is embedding one or more links in the third portion referencing information contained in the second portion. Whether Gonzales provides the functionality of enabling a viewer to interpret occurrences of noun phrases is completely irrelevant as it is not claimed in any of the independent claims or dependent claims.

Appellant further argues that the combination of Sweet and Gonzales would not provide the specific structure between the claimed structures on page 6 of the Brief. Appellant further argues that the references are silent on the specific structure and they do not address the interpretation requirements for language used in the third portion and the second portion. It is unclear what "interpretation requirements" the Appellant is referring to. It appears that limitations from the specification are being read into the claim when those features are not claimed. Appellant claims that the combination of Gonzales and Sweet would be inoperative. Examiner strongly disagrees.

Examiner agreed that Gonzales does not expressly teach the one or more external documents are "viewable using a viewer application"; although he does teach

Art Unit: 2176

viewing the documents via a browser. Examiner then relied on Sweet. Sweet teaches retrieving documents linked to an initial document. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers **an initial document specified by a URL** and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***“documents viewable using a viewer application”***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In other words, it is certainly possible and desirable to view a document using a viewer application as taught by Sweet. In fact, Sweet even states that a document specified by a URL (i.e. a hyperlink) may be retrieved and viewed in a PDF viewer. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

Appellant further argues that the combination cannot provide the benefit of reviewing and comprehending the document through explanatory links. Again, Examiner notes that these are features that are being read into the claims and are not in fact claimed. Further it is noted, the Appellant states on page 7, "the combination of Gonzales and Sweet would result in web pages that may be linked to a PDF document specified by a URL and other documents linked to the initial documents". This statement appears to agree that Gonzales and Sweet, in combination, teach that an external document is viewable using a viewer application.

Appellant argues on page 9 of the Brief, that the invention is not about a web page with links pointing to points within the document or to another document but specifically about a portable electronic document having three portions where the third portion is interpreted based on information provided in the second portion. Examiner disagrees that this is the invention. Nowhere do the claims discuss the third portion is interpreted based on information provided in the second portion. In fact the claim merely states, "embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application; and embedding one or more links in the third portion referencing information contained in the second portion".

Appellant further argues on page 9 that Gonzales and Sweet fail to teach the language of the dependent claims.

Regarding claim 2, Appellant argues there is no showing that the document is a PDF document residing in a PDF file. As stated in the rejections above, Gonzales does not teach the document is a PDF document residing in a PDF file; however Sweet does.

Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***“documents viewable using a viewer application”***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

Regarding claim 3, Appellant argues there is no showing of encapsulating one or more links into a PDF file. While Gonzales does not teach encapsulating one or more links into a PDF file, Sweet does. Sweet teaches the PDF document may have hypertext links to web pages, as well as internal pages within the document. The link is integrated into the PDF document and displayed by the PDF viewer. See column 8, lines 42-50. It would have been obvious to a person of ordinary skill in the art at the time of the invention to encapsulate the links into the PDF file because it allows a user to link to a page within the PDF document. See column 8, lines 42-50.

Regarding claim 4, as stated in the rejections, Gonzales does not teach the viewer application is a PDF application; however, Sweet does. Sweet teaches in response to a request from a user, a PDF viewer may retrieve from one or more web servers an initial document specified by a URL and other documents which are linked to the initial document. See column 8, lines 26-50. The PDF document is displayed by the PDF viewer. See column 8, lines 26-50. Compare to ***“documents viewable using a viewer application”***. It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide a viewer application to view documents referenced in Gonzales' system because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

In reference to claim 5, Gonzales does not teach retrieving one or more pages of an external document referenced by a link and consolidating all pages into the external document; however, Sweet does. Sweet teaches a web page integrator which is a part of a PDF viewer. The PDF viewer may request the integrator to retrieve from one or more web servers, an initial document specified by a URL supplied by the user or other documents which are linked, directly or indirectly, to the initial document. When the documents are retrieved, the web page integrator integrates them into a single PDF document which is then displayed by the PDF viewer. See column 8, lines 26-41. It would have been obvious to a person of ordinary skill in the art at the time of the

invention to consolidate all pages into the external document because it was desirable to provide a means to convert a semantic markup representation of a document into a physical markup representation of the document (i.e. PDF) as it provides a common and convenient way for display data to be stored as a single document, having a fixed page size. See columns 3-4 of Sweet.

With respect to claim 6, Appellant argues neither Gonzales nor Sweet teaches the electronic document comprises a patent or patent application wherein the first portion is a prior art section, the second portion is a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section.

As previously noted in the rejections regarding claim 6, Gonzales teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2.

Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description

of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text, sentences, and paragraphs. Gonzales and Sweet teach that documents comprise text. See page 3, paragraph [0046] of Gonzales.

As Examiner has noted in the previous office actions, dated 03/06/06 and 06/27/06, and in a previous interview on 04/12/06, a electronic document comprising a claim section, description section, or prior art section is simply viewed as a document comprising text. A claim of a patent is merely a sentence. The "description" of a document is merely text in the form of paragraphs and "prior art" is also merely text. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is noted that on pages 9-12 Appellant argues that none of the claim features of the pending claims are taught by the reference. Appellant merely argues that the limitations are not taught without pointing out why the portions of the reference that the Examiner purports teaches the recited claim limitations does not in fact teach what the Appellant is claiming. Broad, general statements alleging that the Examiner has not taught the claim limitations without reasons why the cited portions of the reference do not teach the limitations are mere pleadings and fail to provide evidence to the contrary.

In reference to claim 7, Gonzales teaches a web page (i.e. document) includes areas designated to contain content e.g., text and images, or to provide navigation bars



(nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a claim section; however, the claim section is merely a paragraph of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 10, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet

teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a the claim of a patent application and file history because a claim and file history are simply text.

In reference to claim 11, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claims 12-13, Gonzales teaches a database contains data relating to articles and documents that are developed by the users of system over the Internet. See pages 2, paragraph [0040] and page 3, paragraphs [0045].

In reference to claim 14, Gonzales further teaches a web page (i.e. document) include areas designated to contain content e.g., text and images, or to provide navigation bars (nav) from a presently displayed page to another. These areas can comprise several regions. See figure 2. A hyperlink, or link, is a text or image area on which a user can click to connect to or reference another document or content component. A link can connect two web pages, i.e., an internal link, or two websites, i.e., an external link. See page 3, paragraphs [0045]-[0047] and figure 2. Neither Gonzales nor Sweet disclose the document comprises a patent or patent application where the first portion is a prior art section, the second portion is a description section, and the third section is a claim section; however, the prior art section, description and claim sections are merely paragraphs of a document. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

In reference to claim 15, Gonzales teaches the document comprises text. This text could be related to a patent application or patent. As both Gonzales and Sweet teach that the documents comprise text (See page 3, paragraph [0046] of Gonzales), it

would have been obvious to a person of ordinary skill in the art at the time of the invention to draft the document such that the text depicted a description of an invention, a claim of a patent application, or listed prior art references because a description, claim, and prior art are simply text.

Examiner notes that Claim 15 was rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement *in all of the previous office actions*. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites "mapping intellectual property for an industry covered by the patent or patent application". It is unclear what the claim is intended to mean, as there is no description for this feature in the Appellant's specification.

It is noted, Appellant has not provided arguments and/or amendments for claim 15 despite previous rejections.

On pages 12-13 of the Brief, Appellant argues there is no suggestion to combine Fogel with Gonzales/Sweet with respect to claims 8-9. Specifically, Appellant argues that since the references do not teach a prior art section, descriptions section, or claim section, there would be no motivation to visualize the claims in a tree view or drilling down detail of each claim in a tree view. As stated in the rejections above, Gonzales/Sweet do not teach visualizing the claims in a tree view or drilling down details of each claim in the tree view; however Fogel does. Fogel teaches a method of checking semantic and syntactical correctness of claims in a claim tree format. The

dependencies tree for each claim is built with at least one independent claim. See abstract and page 8.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to represent patent claims in a tree view as it depicts the relationships among independent and dependent claims or simply among text. See page 5, paragraph [0229].

Further, an electronic document comprising a claim section, description section, or prior art section is simply viewed as a document comprising text. A claim of a patent is merely a sentence. The "description" of a document is merely text in the form of paragraphs and "prior art" is also merely text. Further, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art section, description and claim sections are merely paragraphs of a document.

On pages 13-14, Appellant argues that Mahoney is not combinable with Gonzales/Sweet and actually teaches away from the use of OCR. As stated in the rejections above, Gonzales/Sweet do not disclose using OCR from an image of the page and associating text with the corresponding location of the text in the image; however, Mahoney does. Mahoney teaches it was well known at the time of the invention to utilize OCR for search and retrieval of a document image. OCR distinguishes each bitmap of a character from its neighbor, analyzes the appearance,

and distinguishes it from other characters in a predetermined set of characters. See page 3, lines 5-51. Mahoney further teaches scanned images may be represented as PDF documents. See column 1, lines 34-40.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to enable searching a document using OCR in a PDF document as it was desirable at the time of the invention to search for a document stored in a large database particularly hardcopy documents that are scanned as images having no structural definition as it would not be perceivable by a computer, thus there was a need to analyze image data and pixels to help identify a document stored in a large corpus of documents. See columns 1-2 of Mahoney.

Examiner disagrees that Mahoney does not teach that OCR techniques were common at the time of the invention. The Mahoney reference clearly discloses that using OCR techniques were well known in the art in the background of the invention on pages 1-2.

Regarding claim 18, Appellant argues the combination of the references was made using hindsight. Examiner disagrees. As stated in the rejections above, Gonzales/Sweet do not teach saving user annotations in the document; however, Bargerón does. Bargerón teaches the anchoring of annotations to content. On page 1, paragraph [0005], *Bargerón discloses an annotation is associated with a particular portion of content*. It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate Bargerón's annotation in the document in the system of Gonzales/Sweet as it was desirable to provide a means to preserve the

Art Unit: 2176

annotations in a digital document because digital documents are easily and frequently altered, thereby changing the portion of the document to which the annotation corresponds. It would thus be beneficial to provide a way to improve the manner in which annotations are associated with portions of documents so that the annotations are still associated with the correct portion of the document despite alterations to the underlying content. See page 1, paragraph [0004].

Bargeron clearly states why it was desirable to provide an annotation with content of a document on page 1, paragraph [0004]. Specifically, it was desirable to provide a means to preserve the annotations in a digital document because digital documents are easily and frequently altered, thereby changing the portion of the document to which the annotation corresponds. It would thus be beneficial to provide a way to improve the manner in which annotations are associated with portions of documents so that the annotations are still associated with the correct portion of the document despite alterations to the underlying content. See page 1, paragraph [0004].

***Rejection of claim 15 under 35 USC § 112, 1<sup>st</sup> paragraph***

It is further noted that the rejections made under 35 U.S.C. 112, 1<sup>st</sup> paragraph have not been overcome by any arguments and/or amendments in any of the Appellant's previous Responses. Accordingly, the rejections under 35 U.S.C. 112, 1<sup>st</sup> paragraph are maintained. In view of the comments above, the rejection is maintained.

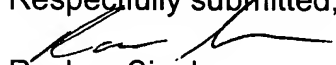
Art Unit: 2176

**(11) Related Proceeding(s) Appendix**

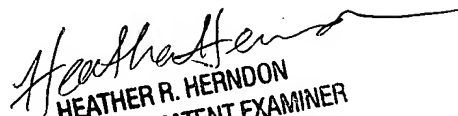
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Rachna Singh

Conferees:

  
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